

be found at paragraphs numbered 6, 7 and 8 wherein the first step is to determine whether and in what aspect the reissue claims are broader than the parent claims. Then the second step is to determine whether the broader aspects of the reissued claims related to surrendered subject matter and thirdly, the final step is that the court must determine whether the reissue claims were materially narrowed in other respects to avoid the recapture rule. It is proffered that in the instant situation the claims were materially narrowed in other respects to avoid the recapture rule. As concerns the analysis of claim 1, certain portions were alleged to have been added to determine and distinguish the prior art, which analysis is not correct. For example, the action says that specific reference to "the abduction dimension and lithotomy dimensions were made by amendment in lines 2 and 3 of old claim 1. Original claim 1 included the abduction dimension and lithotomy dimension and this was not added. Attached hereto is a comparison of claim 14 and claim 1 that was previously submitted wherein items highlighted by yellow are the words that were added into patent claim 1 by way of amendment. This reissue references a plurality of axis and does not limit them to the abduction and lithotomy dimensions. It does reference that there are a support device and that is moveable by a first and plurality of axis relative to the support device. The claim does reference clamping although it does not reference simultaneous clamping. The claim also references releasing of rotative movement relative to the mounting device which is a limitation not previously in the patent claim. The claim further is limited that the cradle is moveable about the first plurality of axis when the support device is clamped against moving about the second plurality of axis. Here instead of having a single second axis, there is a plurality. Here also the operator device is recited as being remote from the actuator, a limitation not in the patent. Additionally, the operator device is referenced as being operatively coupled to the actuator. Hence, as can be seen, applicant is not attempting to recapture what was given up, but comes within the provision of additional limitations while

removing the concept of the longitudinal axis relationship of patent claim 1. Thus, according to the doctrine set forth in the Pannu decision, supra, recapture is not being attempted. Accordingly, reconsideration of this rejection is requested.

In view of the above, the application is now deemed to be in condition for allowance and such is respectfully requested.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (20341/29488).

Respectfully submitted,

BARNES & THORNBURG



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Claim [1] 14 A leg [holder system for simultaneous] positioning apparatus [in an abduction dimension and a lithotomy dimension] comprising:

a support device[, having a longitudinal axis, for supporting]

a leg cradle coupled to the support device and moveable about a first plurality of axes relative to the support device;

a clamping device [for mounting a proximate end of said] coupling the support device to a mounting device [having a first axis transverse to said longitudinal axis and selectively simultaneously clamping and releasing motion of said support device about said first axis and] the clamping device being configured to clamp the motion of the support device relative to the mounting device and to release the support device for rotative movement relative to the mounting device about a second [axis transverse to both said first axis and said longitudinal axis, said support device fixed in said clamping device from rotation about said longitudinal axis] plurality of axes, the leg cradle being moveable about the first plurality of axes when the support device is clamped against movement about the second plurality of axes;

an actuator device to move the [for actuating said] clamping device to [simultaneously] selectively clamp and release the [said] support device [and said] relative to the mounting device; and

an operator device remote from the [said] clamping device and remote from the [said] actuator device the operator device being operatively coupled to the [for operating said] actuator device [to enable said support device to move jointly about both said first and said second axes in the abduction and lithotomy dimensions], the operator device being configured to operate the actuator device.

Claim [1] 24 A leg [holder system for simultaneous] positioning apparatus [in an abduction dimension and a lithotomy dimension] comprising:

a mounting [support] device, [having a longitudinal axis, for supporting]

an elongated member,

a leg [cradle;] holder adapted to engage and support at least a portion of a leg of a patient, a coupler configured to couple the leg holder to the elongated member, the coupler being configured to permit adjustment of a position of the leg holder relative to the elongated member about a first plurality of axes,

a locking [clamping] device [for mounting a proximate end of said] coupled

[support device] to the [a] mounting device and coupled to the elongated member, the locking [having a first axis transverse to said longitudinal axis and selectively simultaneously

59 U.S.P.Q.2d 1597

United States Court of Appeals,
Federal Circuit.Jaswant S. PANNU and Jaswant S. Pannu, M.D., P.A., Plaintiffs-Appellants,
v.

STORZ INSTRUMENTS, INC., Defendant-Appellee.

No. 00-1482.

July 25, 2001.

Owner of reissued patent for intraocular lens brought patent infringement action against competitor, and competitor counterclaimed for a declaratory judgment that patent was invalid. The District Court, 106 F.Supp.2d 1304, William P. Dimitrouleas, J., granted competitor summary judgment on counterclaim, on grounds that patent was invalid under recapture rule. Patentee appealed. The Court of Appeals, Mayer, Chief Judge, held that: (1) reissue claim broadened original claim; (2) reissue claim related to subject matter surrendered during prosecution of original patent; (3) reissued claims were not narrowed in any material respect compared with their broadening from original patent claims; and (4) under recapture rule, patentee was estopped by prosecution history from recapturing limitation in original patent claim.

Affirmed.

West Headnotes



[1] KeyCite Notes

☞ 170B Federal Courts

☞ 170BVIII Courts of Appeals

☞ 170BVIII(K) Scope, Standards, and Extent

☞ 170BVIII(K)1 In General

☞ 170Bk776 k. Trial De Novo. Most Cited Cases

A district court's grant of summary judgment is reviewed de novo on appeal.



[2] KeyCite Notes

☞ 291 Patents

☞ 291XII Infringement

☞ 291XII(C) Suits in Equity

☞ 291k314 Hearing

☞ 291k314(5) k. Questions of Law or Fact. Most Cited Cases

☞ 291 Patents

☞ 291XII Infringement

☞ 291XII(C) Suits in Equity

☞ 291k324 Appeal

☞ 291k324.5 k. Scope and Extent of Review in General. Most Cited Cases

Determining whether the claims of a reissued patent violate statute governing reissue of defective

patents is a question of law, which appellate courts review de novo. 35 U.S.C.A. § 251.

[3] KeyCite Notes

↳ 291 Patents

↳ 291XII Infringement

↳ 291XII(C) Suits in Equity

↳ 291k324 Appeal

↳ 291k324.55 Questions of Fact, Verdicts, and Findings

↳ 291k324.55(3) Issues of Validity

↳ 291k324.55(3.1) k. In General. Most Cited Cases

In determining whether the claims of a reissued patent violate statute governing reissue of defective patents, the legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence. 35 U.S.C.A. § 251.

[4] KeyCite Notes

↳ 170A Federal Civil Procedure

↳ 170AXVII Judgment

↳ 170AXVII(C) Summary Judgment

↳ 170AXVII(C)1 In General

↳ 170Ak2465 Matters Affecting Right to Judgment

↳ 170Ak2470 k. Absence of Genuine Issue of Fact in General. Most Cited Cases

↳ 170A Federal Civil Procedure

↳ 170AXVII Judgment

↳ 170AXVII(C) Summary Judgment

↳ 170AXVII(C)1 In General

↳ 170Ak2465 Matters Affecting Right to Judgment

↳ 170Ak2470.4 k. Right to Judgment as Matter of Law. Most Cited Cases

Summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law.

[5] KeyCite Notes

↳ 291 Patents

↳ 291XII Infringement

↳ 291XII(C) Suits in Equity

↳ 291k314 Hearing

↳ 291k314(5) k. Questions of Law or Fact. Most Cited Cases

↳ 291 Patents

↳ 291XII Infringement

↳ 291XII(C) Suits in Equity

☞ 291k323 Final Judgment or Decree

☞ 291k323.2 Summary Judgment

☞ 291k323.2(2) k. Presence or Absence of Fact Issues. Most Cited Cases

Patent claim construction is a purely legal question, and therefore, comparison of claims in original patent and a reissue patent is a purely legal question appropriate for summary judgment.

[6] KeyCite Notes



☞ 291 Patents

☞ 291VII Reissues

☞ 291k141 Identity of Invention

☞ 291k141(3) Enlargement of Claims

☞ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

The "recapture rule" prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. 35 U.S.C.A. § 251.

[7] KeyCite Notes



☞ 291 Patents

☞ 291VII Reissues

☞ 291k141 Identity of Invention

☞ 291k141(3) Enlargement of Claims

☞ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

Under the recapture rule, reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. 35 U.S.C.A. § 251.

[8] KeyCite Notes



☞ 291 Patents

☞ 291VII Reissues

☞ 291k141 Identity of Invention

☞ 291k141(3) Enlargement of Claims

☞ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

Application of the recapture rule is a three-step process to determine: (1) whether and in what aspect the reissue claims are broader than the patent claims; (2) whether the broader aspects of the reissued claim relate to surrendered subject matter; and (3) whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. 35 U.S.C.A. § 251.

[9] KeyCite Notes

☞ 291 Patents

☞ 291VII Reissues

 ☞ 291k141 Identity of Invention

 ☞ 291k141(3) Enlargement of Claims

 ☞ 291k141(4) k. Particular Inventions. Most Cited Cases

Patentee's reissue claim necessarily involved broadening of original claim, and thus patentee's reissue patent was invalid under the recapture rule, where patentee admitted in reissue oath that claim was unnecessarily narrowed in original patent, and reissue claim eliminated limitation in original patent on shape of haptics for patented intraocular lens. 35 U.S.C.A. § 251.

KeyCite Notes

[10]

☞ 291 Patents

 ☞ 291VII Reissues

 ☞ 291k141 Identity of Invention

 ☞ 291k141(3) Enlargement of Claims

 ☞ 291k141(3.1) k. In General. Most Cited Cases

A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. 35 U.S.C.A. § 251.

[11] KeyCite Notes

☞ 291 Patents

 ☞ 291VII Reissues

 ☞ 291k141 Identity of Invention

 ☞ 291k141(3) Enlargement of Claims

 ☞ 291k141(4) k. Particular Inventions. Most Cited Cases

Reissued claim related to subject matter surrendered during prosecution of original patent, and thus patentee's reissue patent was invalid under the recapture rule, where original claim limited patent to particular shape of haptics for intraocular lens, and shape of haptics was broadened during reissue. 35 U.S.C.A. § 251.

[12] KeyCite Notes

☞ 291 Patents

 ☞ 291VII Reissues

 ☞ 291k141 Identity of Invention

 ☞ 291k141(3) Enlargement of Claims

 ☞ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

Reissued claims were not narrowed in any material respect compared with their broadening from original patent claims, as would avoid invalidation of reissue patent under the recapture rule, where narrowing aspect of claim on reissue was related to positioning and dimensions of snag resistant means, rather than shape of haptics for intraocular lens, which was broadened claim. 35 U.S.C.A. § 251.



[13] KeyCite Notes

↳ 291 Patents

↳ 291VII Reissues

↳ 291k141 Identity of Invention

↳ 291k141(3) Enlargement of Claims

↳ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

Patentee was estopped by prosecution history from recapturing limitation in original patent claim he added to overcome prior art rejections, by way of reissue patent, where reissue claims were broader than original patent claims in a manner directly pertinent to subject matter surrendered during prosecution. 35 U.S.C.A. § 251.



[14] KeyCite Notes

↳ 291 Patents

↳ 291VII Reissues

↳ 291k141 Identity of Invention

↳ 291k141(3) Enlargement of Claims

↳ 291k141(6) k. Claiming Matter Abandoned, Disclaimed, or Rejected on Original Application. Most Cited Cases

If the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution, flexibility of analysis is eliminated in determining whether recapture rule is avoided on grounds reissued claims are materially narrowed compared with their broadening, for the prosecution history establishes the substantiality of the change and estops its recapture. 35 U.S.C.A. § 251.



KeyCite Notes

↳ 291 Patents

↳ 291XIII Decisions on the Validity, Construction, and Infringement of Particular Patents

↳ 291k328 Patents Enumerated

↳ 291k328(2) k. Original. Most Cited Cases

4,092,743, 4,159,546, 4,249,271, 4,436,855. Cited.



KeyCite Notes

↳ 291 Patents

↳ 291XIII Decisions on the Validity, Construction, and Infringement of Particular Patents

↳ 291k328 Patents Enumerated

↳ 291k328(4) k. Reissue. Most Cited Cases

32,525. Invalid.

*1368 Michael C. Cesarano, Akerman, Senterfitt & Eidson, P.A., of Miami, FL, argued for plaintiffs-appellants.

Edward W. Remus, McAndrews, Held & Malloy, Ltd., of Chicago, IL, argued for defendant-appellee. With him on the brief was Jonathan R. Sick. Of counsel on the brief were Craig E. Larson, Bausch & Lomb, Incorporated, of Rochester, NY; and Rita D. Vacca, Bausch & Lomb Surgical, Inc., of St. Louis, MO.

Before MAYER, Chief Judge, FRIEDMAN, Senior Circuit Judge, and RADER, Circuit Judge.

MAYER, Chief Judge.

Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A. (collectively Pannu) appeal the judgment of the United States District Court for the Southern District of Florida, Pannu v. Storz Instruments, Inc., 106 F.Supp.2d 1304 (S.D.Fla. 2000), granting summary judgment for Storz Instruments, Inc. (Storz) that U.S. Patent No. Re 32,525 is invalid under 35 U.S.C. § 251, the recapture rule. Because the reissued patent improperly broadened claims in a manner directly pertinent to subject matter surrendered during prosecution, we affirm.

Background

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens. The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end. In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the lens body, and the lens could be placed in either the anterior or posterior chamber of the eye. [FN1]

FN1. The eye is considered to have two chambers separated by the iris. The anterior chamber lies between the back surface of the cornea and front surface of the iris. Attorneys' Dictionary of Medicine and Word Finder A-280 (1995). The posterior chamber is the space between the back surface of the iris and the front surface of the crystalline lens. *Id.* at P-280.

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:

a lens having a width and a thickness;
a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;
and a snag resistant disc joined to the flexible strand's free end;
said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc,

at least 3 times *1369 greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye; said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. § 103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, Pannu filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16. Independent claim 16 reads as follows:

An intraocular lens comprising:

a lens body;

at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

Pannu raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body ... which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue." The examiner accepted Pannu's arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics. Claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 ('855 patent) and reads as follows:

An intraocular lens comprising:

a lens body;

at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body; said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,

said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplemental reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated *1370 by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.' " The examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with italics indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] at least three times greater in [size] width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.

The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

Pannu filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter Pannu surrendered in obtaining allowance of claim 1 of the '855 patent. The court granted Storz's motion for summary judgment of invalidity and Pannu appeals.

Discussion

[1] [KC] [2] [KC] [3] [KC] [4] [KC] [5] [KC] "We review a district court's grant of summary judgment de novo." *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1365, 53 USPQ2d 1377, 1378 (Fed.Cir.2000). Determining whether the claims of a reissued patent violate 35 U.S.C. § 251 is a question of law, which we review *de novo*. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed.Cir.1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed.Cir.1993). This legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed.Cir.1998); *Mentor*, 998 F.2d at 994, 27 USPQ2d at 1524 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1439, 221 USPQ 289, 297 (Fed.Cir.1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Vanmoor*, 201 F.3d at 1365, 53 USPQ2d at 1378. The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. See *Hester*, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174 (Fed.Cir.1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, *Westvaco Corp. v. Int'l Paper Co.*, 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed.Cir.1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review *de novo*.").

[6] [KC] [7] [KC] [8] [KC] The recapture rule "prevents a patentee from regaining through reissue *1371 the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. *Id.* (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Id.* "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." *Id.* Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

[9] [KC] [10] [KC] With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." *Hester*, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, Pannu's reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of Pannu's unnecessary narrowing of claim 1 must involve a corresponding broadening of the reissued claim.

[11] [KC] Pannu argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, Pannu filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Pannu argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. See *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue *1372 avoids the recapture rule. See *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165; *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

[12] [KC] [13] [KC] [14] [KC] The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed.Cir.1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED.

C.A.Fed. (Fla.),2001.

Pannu v. Storz Instruments, Inc.

END OF DOCUMENT

ab·duct

ab·duct (äb-dükt') *verb, transitive*

ab·duct·ed, ab·duct·ing, ab·ducts

1. To carry off by force; kidnap.
2. *Physiology.* To draw away from the midline of the body or from an adjacent part or limb.

[Latin *abdūcere*, *abduct-* : *ab-*, away. See *ab-*¹ + *dūcere*, to lead.]

— **ab·duc'tion** *noun*

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li·thot·o·my

li·thot·o·my (lī-thōt'ē-mē) *noun*

plural **li·thot·o·mies**

Surgical removal of a stone or stones from the urinary tract.

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FULL TEXT OF CASES (USPQ2D)
All Other Cases

**Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CA
FC 2001)**

59 USPQ2D 1597

Pannu v. Storz Instruments Inc.

U.S. Court of Appeals Federal Circuit

No. 00-1482

Decided July 25, 2001

Headnotes

PATENTS

**[1] Practice and procedure in Patent and Trademark Office —
Reissue — Broader claims sought (§110.1313)**

Patentability/Validity — Construction of claims (§115.03)

Patent construction — Prosecution history estoppel (§125.09)
Plaintiff's reissue claim for intraocular lens is invalid on ground of
improper recapture of subject matter surrendered during prosecution
to avoid prior art rejections, since reissue claim eliminated limitation on
shape of "haptics" element of lens, and thus is broader than
corresponding claim of original patent, since this broadened aspect of
claim relates to surrendered subject matter, in that shape of haptics was
same subject matter that was surrendered during prosecution of

original application, and since recapture was not avoided by addition, on reissue, of limitations on haptics' dimensions and positioning, which do not narrow claim in manner directly pertinent to specific aspect that was narrowed during prosecution, namely, shape of haptics.

Particular Patents

Particular patents — General and mechanical — Intraocular lens Re. 35,525 (of 4,435,855), Pannu, universal intraocular lens and a method of measuring an eye chamber size, summary judgment of invalidity affirmed.

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Case History and Disposition

Appeal from the U.S. District Court for the Southern District of Florida, Dimitrouleas, J.

Action by Jaswant S. Pannu and Jaswant S. Pannu M.D., P.A. against Storz Instruments Inc. for patent infringement, in which defendant counterclaimed seeking declaratory judgment of invalidity. District court granted defendant's motion for summary judgment of invalidity, and plaintiff appealed. Affirmed.

Related decision: 47 USPQ2d 1657.

Attorneys:

Michael C. Cesarano, of Senterfitt & Eidson, Miami, Fla., for plaintiffs-appellants.

Edward W. Remus and Jonathan R. Sick, of McAndrews, Held & Malloy, Chicago, Ill.; Craig E. Larson, of Bausch & Lomb Inc., Rochester, N.Y.; Rita D. Vacca, of Bausch & Lomb Surgical Inc., St. Louis, Mo., for defendant-appellee.

Judge:

Before Mayer, chief judge, Friedman, senior circuit judge, and Rader, circuit judge.

Opinion Text

Opinion By:

Mayer, C.J.

Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A. (collectively Pannu) appeal the judgment of the United States District Court for the Southern District of Florida, *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304 (S.D. Fla. 2000), granting summary judgment for Storz Instruments, Inc. (Storz) that U.S. Patent No. Re 32,525 is invalid under 35 U.S.C. §251, the recapture rule. Because the reissued patent improperly

broadened claims in a manner directly pertinent to subject matter surrendered during prosecution, we affirm.

Background

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens. The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end. In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the lens body, and the lens could be placed in either the anterior or posterior chamber of the eye.¹ Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:
a lens having a width and a thickness;
a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;
and a snag resistant disc joined to the flexible strand's free end;
said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;
said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. §103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, Pannu filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16. Independent claim 16 reads as follows:

An intraocular lens comprising:
a lens body;

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at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;
said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and
snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

Pannu raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a

diameter greater than the diameter of the lens body ...which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue." The examiner accepted Pannu's arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics. Claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 ('855 patent) and reads as follows:

An intraocular lens comprising:

a lens body;

at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens, said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplemental reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with italics indicating additions and bracketing indicating deletions:

 said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] *at least three times* greater in [size] *width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.*

The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

Pannu filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter Pannu surrendered in obtaining allowance of claim 1 of the '855 patent.

The court granted Storz's motion for summary judgment of invalidity and Pannu appeals.

Discussion

"We review a district court's grant of summary judgment de novo." *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1365, 53 USPQ2d 1377, 1378 (Fed. Cir. 2000). Determining whether the claims of a reissued patent violate 35 U.S.C. §251 is a question of law, which we review *de novo*. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). This legal conclusion can involve underlying findings of

fact, which are reviewed for substantial evidence. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647(Fed. Cir. 1998); *Mentor*, 998 F.2d at 994, 27 USPQ2d at 1524 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1439, 221 USPQ 289, 297(Fed. Cir. 1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Vanmoor*, 201 F.3d at 1365, 53 USPQ2d at 1378.

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The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. See *Hester*, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174(Fed. Cir. 1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, *Westvaco Corp. v. Int'l Paper Co.*, 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed. Cir. 1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review de novo.").

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. *Id.* (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Id.* "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." *Id.* Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

[1] With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." *Hester*, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, Pannu's reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of Pannu's unnecessary narrowing of claim 1 must involve a corresponding broadening of the reissued claim.

Pannu argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, Pannu filed a supplemental

amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Pannu argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. See *Southwall Techs., Inc. v. Cardinal AG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676(1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue avoids the recapture rule. See *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165; *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on

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reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634(Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED

Footnotes

1 The eye is considered to have two chambers separated by the iris. The anterior chamber lies between the back surface of the cornea and front surface of the iris. Attorneys' Dictionary of Medicine and Word Finder A-280 (1995). The posterior chamber is the space between the back surface of the iris and the front surface of the crystalline lens. *Id.* at P-280.

- End of Case -